

REMARKS

Claims 1-35 are currently pending in this application, with claims 1, 23 and 31 being independent claims drawn to methods for treating prostate neoplasia, cancerous tumors, and side effects, respectively. Claim 1 has been amended to remove the recitation of preventing the specific ailments. The claim amendments are based on the specification as originally filed, and thus do not introduce any new matter within the meaning of 35 USC 132 into the application.

Claims 1-22 stand rejected under 35 USC 112, first paragraph, as being based on a non-enabling disclosure. Claims 1-35 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-43 of U.S. Patent Application Serial No. 10/728,085.

The above amendments and following comments are made in anticipation that they will place the application in condition for allowance. With entry thereof, Applicants respectfully submit that the claims are now in condition for allowance.

1. Rejection of Claims 1-22 Under 35 U.S.C. 112, First Paragraph

Claims 1-22 stand rejected under 35 USC 112, first paragraph as being based on a non-enabling specification for the reasons set forth in the Office Action.

RESPONSE

Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof.

The Examiner indicates that the claims are not enabled by the specification because the use of the word "prevent" in claim 1. The Examiner argues that "preventing" has an absolute definition meaning to stop from occurring, and that the specification is not enabling for this feature.

Applicants have amended claim 1 to remove the term "prevent" therefrom, thus rendering this rejection moot. Therefore, Applicants respectfully submit that the specification is now enabling for claims 1-22.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

2. Rejection of Claims 1-35

under Obviousness-Type Double Patenting

Claims 1-35 stand provisionally rejected under the doctrine of obviousness-type double patenting over claims 1-43 of co-pending application no. 10/728,085, for the reasons set forth in the office action.

RESPONSE

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting grounds provided the conflicting application or patent is shown to be commonly owned with this application. Accordingly, a terminal disclaimer disclaiming the term of the instant application which would extend beyond the expiration of a patent granted on application no. 10/728,085 is being filed herewith. The filing of the terminal disclaimer, though, is not an admission that the claims of the present application are obvious over the claims of the '085 application, and is not to be construed as such. The terminal disclaimer is being filed only for expediency to overcome the rejection and advance prosecution of this application.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-35 under the judicially created doctrine of double patenting.

CONCLUSION

In view of the foregoing, applicant respectfully requests the Examiner to reconsider and withdraw the rejection of the claims and

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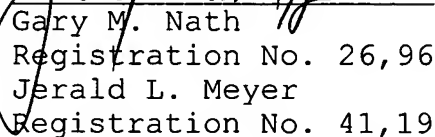
to allow all of the claims pending in this application.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

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Respectfully submitted,
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